

REMARKS

Formal Matters

Claims 8 and 10 were examined and stand rejected.

Claims 8, 10, 17-19 are pending after entry of the amendments set forth herein.

Applicants respectfully request reconsideration of the application in view of the amendments and remarks made herein.

Support for the amendments to claims 8 and 10 can be found throughout the specification, at, for example, page 6, line 15-25, and pages 51-53. Support for new claims 17-19 can be found throughout the specification, at, for example, page 52, line 14 though page 53, line 10. As such, no new matter has been added.

Rejection under 35 U.S.C. § 112, 1st paragraph.

Claims 8 and 10 stand rejected under 35 U.S.C. § 112, 1st paragraph. Specifically, it is asserted in the Office Action that the specification does not provide an adequate written description for or enable any person skilled in the art to which it pertains, or with which it is most nearly connected to make and use the invention commensurate in scope with these claims. (Office Action, page 4)

The Office Action asserts that “the specification has taught the generation of . . . a transgenic knockout mouse, the specification has not taught the generation of the other transgenic non-human animals.” It is also asserted that the specification does not provide an adequate written description for or enable the claimed invention for any and all cells other than murine ES cells. The Office Action recommends “limiting claim 8 to a transgenic mouse whose genome comprises a homozygous disruption of the nucleotide sequence set forth in SEQ ID NO: 1 and claim 10 to an ES cell would be sufficient to overcome this aspect of the rejection.” (Office Action, page 7-8) As such, applicants have adopted this recommendation and amended claims 8 and 10 accordingly.

Examiner asserts that the “it would have required undue experimentation for the skilled artisan to use a transgenic non-human knockout animal that lacks a phenotype.” (Office Action, page 9) The Office Action recommends that “inclusion of a phenotype

associated with a disruption of the nucleotide set forth in SEQ ID NO: 1 in a mouse in the claim would overcome this aspect of the rejection.” (Office Action, page 9) As such, applicants have adopted this recommendation and amended the claims accordingly.

In light of the foregoing, Applicants submit that the rejections of the above-cited claims under 35 U.S.C. § 112, first paragraph, both as to enablement and written description, are overcome in view of the amendments, claim cancellations, and remarks set forth herein. The Examiner is thus respectfully requested to withdraw these rejections.

Conclusion.

Applicants submit that all of the pending claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1271.

Respectfully submitted,
DELTAGEN, INC.

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